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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,883	07/23/2001	Boris Gefwert	BP102075	2318

466 7590 01/21/2005

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EXAMINER

CHEN, SHIN HON

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/909,883

Applicant(s)

GEFWERT, BORIS

Examiner

Shin-Hon Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/14/02, 8/14/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

1. Claims 1-12 have been examined.

### *Specification*

#### Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
  - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
  - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and

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problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the

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World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 recites the limitation "the address information" in line 5. There is insufficient antecedent basis for this limitation in the claim.
4. Claim 4 recites the limitation "the first intermediary directory" in line 2. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 7 recites the limitation "said document" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4, 6, 8, and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kahn et al. PCT Publication No. WO 97/43717 (hereinafter Kahn).

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8. As per claim 1 and 8, Kahn discloses a method for managing data transmission in a data network, characterized in that said method comprises the following steps, where a determined piece of information is stored in a storage location according to a predetermined address (Kahn: page 3 lines 15-32), the address information that determines said address is transmitted to the intermediary (Kahn: page 3 line 15 – page 5 line 14), information of at least one user who has the right to access said determined piece of information is transmitted to the intermediary (Kahn: page 5 lines 25 – page 6 line 6), said address information is stored in the user-specific directory of the intermediary, in which directory said at least one user has access (Kahn: page 3 lines 15-32), and said determined piece of information is transmitted to the user on the basis of said address information (Kahn: page 5 lines 15-32).

9. As per claim 4 and 11, Kahn discloses the method of claim 1. Kahn further discloses between the user and the intermediary directory, there is established a connection on the basis of user verification (Kahn: page 5 line 15 – page 6 line 20).

10. As per claim 6, Kahn discloses the method of claim 1. Kahn further discloses the intermediary transmit a given information to the user (Kahn: page 5 lines 4-14).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 3, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn.

13. As per claim 2 and 9, Kahn discloses the method of claims 1 and 8 respectively. Kahn does not explicitly disclose said address information is encrypted by using the user's public key, in which case the address information encryption can be decoded by the user. However, Kahn discloses that the public key cryptography is well known in the art for handling the privacy and authentication in digital network environment (Kahn: page 3 lines 10-13). Therefore, It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to communicate any secure information between two parties using public key cryptography.

14. As per claim 3 and 10, Kahn discloses the method of claims 1 and 8 respectively. Kahn does not explicitly disclose said user information is encrypted by the intermediary's public key, in which case the intermediary decodes the user information encryption and records the address information in a user-specific intermediary directory on the basis of said user information. However, Kahn discloses that the public key cryptography is well known in the art for handling the privacy and authentication in digital network environment (Kahn: page 3 lines 10-13). Therefore, It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to communicate any secure information between two parties using public key cryptography.

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15. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn in view of Muralidhran et al. U.S. Pat. No. 6341351 (hereinafter Muralidhran).

16. As per claim 5 and 12, Kahn discloses the method of claims 4 and 11 respectively. Kahn as modified does not explicitly disclose there are created two intermediary directories, in which case between the user and the first intermediary directory, there is established a connection on the basis of a first verification of the user, and in between the user and the secondary intermediary directory, there is created a connection on the basis of a second verification of the user, in which case the first and second verification are mutually different as regards the reliability typical of said verification procedure. However, Muralidhran discloses different types of authentication for different level of access request. It would have been obvious to one having ordinary skill in the art to apply different authentication procedure for different data access. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Muralidhran within the system of Khan because it is well known in the art to perform further authentication when the security level increases.

17. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn in view of Downs et al. U.S. Pat. No. 6226618 (hereinafter Downs) and further in view of Shimizu et al. U.S. Pat. No. 6684198 (hereinafter Shimizu).



18. As per claim 7, Kahn discloses the method of claim 6. Kahn does not explicitly disclose the user sends the intermediary a request for receiving a given piece of information, an encryption decoding key for decoding the encryption of said given piece of information is transmitted to the user, the transmission of said encryption decoding key is registered as an indication of the reception of said document. However, Downs discloses using receiver's public key to encrypt data decryption key and send it to intermediary and intermediary decrypt it and re-encrypt it using receiver's public key and transmit the encrypted decryption key to the receiver for decryption (Downs: column 3 lines 41-55). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Downs within the system of Kahn because it is well known in the art to provide decryption key to user after the user has been authenticated. Kahn as modified does not explicitly disclose the transmission of encryption decoding key is registered as an indication of the reception of said document. However, Shimizu discloses that limitation (Shimizu: column 5 lines 6-18). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Shimizu within the combination of Kahn-Downs because it allows the intermediary to keep track of the usage and to charge users accordingly.

### ***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Boesjes U.S. Pat. No. 6799165 discloses apparatus and method for inventory, sale, and delivery of digitally transferable goods.

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Shoroff et al. U.S. Pat. No. 6381602 discloses enforcing access control on resources at a location other than the source location.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Hon Chen whose telephone number is (571) 272-3789. The examiner can normally be reached on Monday through Friday 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shin-Hon Chen  
Examiner  
Art Unit 2131

SC

